

REMARKS

The Applicant wishes to thank the Examiner for his examination of the present application. Claims 1, 27, 28, and 31-39 have been amended. Claims 1 and 3-46 are pending in the case. No new matter has been added.

35 U.S.C. §112

Claims 32-38 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the office action asserts that claims 32 and 33 are dependent on themselves which is improper and thus all claims depending from these claims lack antecedent basis. Claims 32 and 34-38 have been amended to depend on claim 31, and claim 33 has been amended to depend on claim 32. Applicants submit that amended claims 32-38 comply with the requirements of 35 U.S.C. §112, second paragraph.

35 U.S.C. §102

Claims 1, 12-14, 16-18, 26, 28-31 and 39-43 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,681,354 (Eckhoff). Claim 1 is directed at an implant for implantation on a femoral condyle. The implant includes, in part, a bone-facing implant surface that opposes at least a portion of the femoral condyle and the trochlea. At least a portion of the bone-facing implant surface has a three-dimensional shape that substantially matches the shape of at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts.

Nowhere does Eckhoff disclose that at least a portion of the bone-facing implant surface has a three-dimensional shape that substantially matches the shape of at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts, as required by claim 1. Eckhoff is directed at an asymmetric distal femoral prosthetic device having a sulcus angled laterally upward and preferably laterally displaced from the midline (see Eckhoff at abstract). However, the text of Eckhoff fails to address the shape of the bone-facing implant surface. Moreover, while Fig. 1 of Eckhoff shows the femoral prosthetic device 10, nowhere is there any indication that the bone-facing implant surface has a three-dimensional shape that substantially abuts and matches an uncut articular surface.

Nor is a bone-facing implant surface having a three-dimensional shape that substantially abuts and matches an uncut articular surface inherent in Eckhoff. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Since Eckhoff neither teaches nor suggests at least a portion of the bone-facing implant surface having a three-dimensional shape that substantially matches the shape of at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts, as required by amended claim 1, amended

claim 1 is not anticipated under 35 U.S.C. §102(b) by Eckhoff. Claims 12-14, 16-18, 26 and 40-43 depend from claim 1 and are allowable over Eckhoff for the same reason as claim 1, as amended, and are further allowable in view of the additional limitations set forth therein.

Independent claim 28 and dependent claims 29 and 30 are directed at an implant for implantation on a femoral condyle, the implant including, in part, a bone-facing implant surface having a three dimensional shape that substantially matches the shape of an uncut articular surface that the implant abuts. Thus, claims 28-30 are allowable over Eckhoff for the same reason as claim 1, as amended, and are further allowable in view of the additional limitations set forth therein.

Independent claim 31 is directed at an implant for implantation on a femoral condyle, the implant including, in part, a bone-facing implant surface and a joint-facing implant surface. At least a portion of the joint-facing implant surface has a three-dimensional shape that substantially matches the shape of at least a portion of the uncut articular surface that the bone-facing surface of the implant abuts.

Nowhere does Eckhoff disclose that at least a portion of the joint-facing implant surface has a three-dimensional shape that substantially matches the shape of at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts, as required by claim 31. As described above, Eckhoff is directed at an asymmetric distal femoral prosthetic device having a sulcus angled laterally upward and preferably laterally displaced from the midline (see Eckhoff at abstract). Other than addressing the displacement of the sulcus, Eckhoff fails to address the shape of the joint-facing implant surface,

much less that the joint-facing surface has a three-dimensional shape that matches at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts. Thus, amended claim 31 is not anticipated under 35 U.S.C. §102(b) by Eckhoff.

Independent claim 39 is directed at an implant for implantation on a femoral condyle, wherein at least a portion of both the bone-facing and the joint-facing implant surface has a three-dimensional shape that substantially matches the shape of at least a portion of the uncut articular surface that the bone-facing surface of the implant abuts. Thus, claim 39 is allowable over Eckhoff for the same reason as amended claims 1 and 31, and is further allowable in view of the additional limitations set forth therein.

35 U.S.C. §103

Claims 3-5, 8, 9, 11, 19-25, and 44-46 stand rejected under 35 U.S.C. §103(a) as unpatentable over Eckhoff in view of U.S. Patent Publication No. 2003/0055501 (Fell et al., hereinafter "Fell '501"). Claims 6, 7, 10 and 32-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Eckhoff in view of Fell et al. U.S. Patent Publication No. 2003/0060882 (Fell et al., hereinafter "Fell '882"). Claims 15 and 27 stand rejected under 35 U.S.C. §103(a) as unpatentable over Eckhoff in view of U.S. Patent Publication No. 2004/0167630 (Rolston).

As stated above, Eckhoff fails to teach or suggest a joint-facing or bone-facing implant surface having a three-dimensional shape that substantially matches the shape of at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts, as required by claims 3-11, 15, 19-25, 27, 32-38 and 44-46. Neither Fell '501, Fell '882, nor Rolston teach such a limitation. Since

none of these references teach this required limitation of claims 3-11, 15, 19-25, 27, 32-38 and 44-46, the embodiment of claims 3-11, 15, 19-25, 27, 32-38 and 44-46 are deemed nonobvious over any combination of these references.

It is submitted that the application is in condition for allowance. Consideration of the application and issuance of a notice of allowance are respectfully requested.

It is believed that a three month extension of time is required. Applicants respectfully petition for such an extension. Authorization is hereby given to charge deposit account number 19-4972. If any additional fees are required for the timely consideration of this application, please charge deposit account number 19-4972.

Applicants request that the undersigned, Alexander J. Smolenski, Jr., be contacted if it will assist further examination of this application.

Respectfully submitted,

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